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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ANTON ESSER, ET AL. : EXAMINER: CORDRAY, D. R.
SERIAL NO: 10/590,933 :
FILED: AUGUST 28, 2006 : GROUP ART UNIT: 1791
FOR: METHOD FOR PRODUCING :
PAPER, PAPERBOARD AND
CARDBOARD

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated June 11, 2010 (Answer).

The statement of the Grounds of the Rejection (Answer at 3-10) is essentially identical to the statement in the Final Rejection, which has already been responded to in the Appeal Brief. The only addition thereto is the Examiner's statement that "Applicants admit that Auhorn et al is drawn to the claimed papermaking utility (see p.12 of the Brief, last line)" (Answer at 8, 9 and 10). In addition, the Response to Argument (Answer at 10-16) includes the Examiner's responses in the Final Rejection to Applicants' arguments made in the amendment filed April 24, 2009, and the Examiner's responses in the first Advisory Action dated December 28, 2009 to Applicants' arguments made in the Amendment under 37 C.F.R. § 1.116 filed December 11, 2009, which Examiner's responses have already been responded

to in the Appeal Brief. Thus, the following is in reply to new arguments presented in the Response to Argument section of the Answer.

In response to Applicants' argument at page 8 of the Appeal Brief about what Esser intended when he used the word "good" in the Esser Declaration, the Examiner finds that this is "argument of counsel and cannot take the place of evidence in the record" (Answer at 13).

In reply, and as Applicants have asserted in the Appeal Brief, the data speak for themselves. In addition, the Examiner has furnished no evidence as to what would be expected results. Indeed, the Examiner has withdrawn the unfounded statement made in the first Advisory Action that "one of ordinary skill in the art would have predicted that, in a more concentrated slurry (such as the thick stock), improved contact would be made between the vinylamine polymer and the pitch particles and better retention obtained" (Answer at 13-14).

The Examiner finds that Applicants' statement at page 10 of the Appeal Brief that the term "400 g/t" in the Esser Declaration refers to the coated broke is "argument of counsel and cannot take the place of evidence in the record" (Answer at 14).

In reply, considering the context in which that statement was made, and by comparing the description of the paper stock used in the examples in the specification and in the examples of the Esser Declaration, the explanation in the Appeal Brief is the most plausible one. It is also true.

Regarding Applicants' argument that Burkert et al is drawn to a flocculent for sludge, not paper-making, the Examiner finds that this is irrelevant, because Burkert et al is cited in Auhorn et al for a method of making polymers containing vinylamine units (Answer at 14-15).

In reply, Auhorn et al discloses that "[i]t is known that polymers containing vinylamine units are prepared by homo- or copolymerization of N-vinylformamide and

subsequent hydrolysis of the polymers with acids or bases” citing, *inter alia*, Burkert et al (column 2, lines 53-58). Such polymers are among a long list of what Auhorn et al refers to as “process chemicals” (column 2, lines 30-58) for use in the process of Auhorn et al’s invention, which is a process for the production of paper by draining a paper stock containing process chemicals on a paper machine in which a head box feed divided into a main stream of the paper stock and a dilution stream consisting of white water are fed via a head box to the paper machine wire, said dilution stream amounting to 5-35% by volume of the total head box feed, and wherein at least 5% by weight of the process chemicals are metered into said dilution stream (column 1, lines 58-66). Thus, the actual inventive method of Auhorn et al is different from that of the present claims notwithstanding the particular polymers used. While Applicants may have stated that “[w]hile Auhorn et al may be drawn to the presently-claimed paper-making utility,” Applicants meant only that Auhorn et al was drawn to a process for producing paper by draining a paper stock comprising interfering substances.

Applicants reiterate that the combination of Auhorn et al and Burkert et al still does not render the present invention *prima facie* obvious for reasons discussed in the Appeal Brief.

Regarding the Examiner’s argument about the use of vinylamine polymers for a different utility (Answer at 15-16), none of the applied prior art discloses the particular steps of the present claims wherein the recited polymers are added for a different reason. Thus, the Examiner’s point is irrelevant.

Regarding the obviousness-type double patenting rejections (Answer at 16), Applicants maintain the arguments made in the Appeal Brief, noting additionally, as discussed above, the context in which Applicants had stated that Auhorn et al may be drawn to the presently-claimed paper-making utility.

Application No. 10/590,933
Reply Brief

Applicants continue to maintain that all of the rejections should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220
(OSMMN 08/09)

A handwritten signature in black ink, appearing to read "H. A. Pitlick", written over a horizontal line.

Harris A. Pitlick

Registration No. 38,779